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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/601,744	06/23/2003	Liesl Thomas		5760

7590 03/08/2004

PLANTHAVEN, INC  
GEOFFREY NEEDHAM  
121 W. PUEBLO St., Ste 14  
P.O. Box 3056  
Santa Barbara, CA 93130-3056

EXAMINER

BELL, KENT L

ART UNIT PAPER NUMBER

1661

DATE MAILED: 03/08/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

**Office Action Summary**

Application No.

10/601,744

Applicant(s)

THOMAS ET AL.

Examiner

Kent L. Bell

Art Unit

1661

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status***application filed 6/23/03*

- 1) ☒ Responsive to communication(s) filed on \_\_\_\_.
- 2a) ☐ This action is FINAL. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 1 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☒ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 6/23/03 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)  
Paper No(s)/Mail Date \_\_\_\_.
- 4) ☐ Interview Summary (PTO-413)  
Paper No(s)/Mail Date. \_\_\_\_.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: \_\_\_\_.

*K.L. Bell*

**Detailed Action**

**Objection to the Disclosure**

**37 CFR 1.163**

The following is a quotation of section (a) of 37 CFR 1.163:

(a) The specification must contain as full and complete a disclosure as possible of the plant and the characteristics thereof that distinguish the same over related known varieties, and its antecedents, and must particularly point out where and in what manner the variety of plant has been asexually reproduced. In the case of a newly found plant, the specification must particularly point out the location and character of the area where the plant was discovered.

**35 USC § 112**

The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

As specific to United States Plant Patent applications, the specifics of 37 CFR 1.164 (reproduced below) are controlling:

The claim shall be in formal terms to the new and distinct variety of the specified plant as described and illustrated, and may also recite the principal distinguishing characteristics. More than one claim is not permitted.

### Detailed Action

In plant applications filed under 35 U.S.C 161, the requirements of 35 U.S.C. 112 are limited. The following is a quotation of 35 U.S.C. 162:

No plant patent shall be declared invalid for noncompliance with section 112 of this title if the description is as complete as is reasonably possible. The claim in the specification shall be in formal terms to the plant shown and described.

The disclosure is objected to under 35 CFR 1.163(a) and under 35 U.S.C. 112, first paragraph, because the specification presents less than a full, clear, and complete botanical description of the plant and the characteristics which define same per se and which distinguish the plant from related known cultivars and antecedents.

More Specifically:

A. Page 1, lines 18 and 19, Applicant states the instant plant was discovered as a variegated branch on "*Euphorbia epithymoides*". The recitation, as currently written, leads one to believe that the instant plant's parent was the entire species. This cannot be true. Applicant should set forth in the specification the name of the parental cultivar, if named. If unnamed, applicant should simply state --an unnamed plant of--. Correction and/or clarification is necessary.

**Detailed Action**

B. Page 1, lines 24 and 25, Applicant states “The variegation makes ‘First Blush’ a showier variety than other Euphorbia.”. Applicant should insert --known to me-- after “Euphorbia” as it is in the realm of possibility that another Euphorbia unknown to the inventor has the same characteristics.

C. Page 3, lines 5 and 6, Applicant should set forth in the specification the age of the plant when described.

D. Page 3, line 11, Applicant should lowercase “*Epithymoides*” as this is the proper way to set forth a species designation.

E. Page 3, line 14, Applicant states “Parent parent”. This recitation is unclear as it is not understood what applicant is intending. Correction and/or clarification is necessary.

F. Page 3, line 14, Applicant states “Parent parent: *Euphorbia epithymoides*”. The recitation, as currently written, leads one to believe that the instant plant’s parent was the entire species. This cannot be true. Applicant should set forth in the specification the name of the parental cultivar, if named. If unnamed, applicant should simply state --an unnamed plant of--. Correction and/or clarification is necessary.

**Detailed Action**

G. Page 4, line 11, Applicant should delete this line and place the recitation between lines 1 and 2 of the same page.

H. Page 5, before line 1, Applicant should set forth in the specification a subheading titled --Bracts-- to clearly set forth the bract characteristics from the foliage characteristics.

I. Page 5, line 1, Applicant sets forth color designations for the instant plant's bracts. However applicant has not stated whether the color designations set forth are for the upper, lower, or both surfaces. Applicant should set forth in the specification color designations for the upper and lower surfaces with reference to the employed color chart.

J. Page 5, lines 1-6, Applicant should set forth in the specification additional information relative to the instant plant's bracts including the typical and observed bract shape, apex, base, and margin descriptors.

K. Page 5, line 10, Applicant should delete this line and simply insert a subheading titled --Cyathia--.

)

**Detailed Action**

L. Applicant should set forth in the specification information relative to the instant plant's cyathia including the typical and observed cyathia arrangement, number, length, diameter, and coloration with reference to the employed color chart.

M. Page 5, line 13, Applicant should set forth in the specification additional information relative to the instant plant's peduncle including the typical and observed peduncle length.

N. Page 5, lines 14 and 15, Applicant should set forth in the specification additional information relative to the instant plant's floral leaves including the typical and observed floral leaf number, length, and width. Further, applicant should verify the name "floral leaves". This characteristic may be better referred to as --petaloid appendages--.

O. Page 5, lines 16-20, Applicant should set forth in the specification the number of pistils per inflorescence and any other meaningful information relative to the instant plant's reproductive organs including whether pollen is produced, if so, amount, i.e. abundant, moderate, scarce, and pollen coloration with reference to the employed color chart. If pollen is not produced then applicant should state such in the specification.

**Detailed Action**

P. Applicant should set forth in the specification information relative to the instant plant's inflorescence including the typical and observed inflorescence type, length, and diameter.

Q. Applicant should set forth in the specification information relative to the instant plant's flower including the typical and observed flower diameter, depth, lastingness (on the plant).

R. Applicant should set forth in the specification information relative to the instant plant's Disease/Pest Resistance/Susceptibility.

S. Applicant should set forth in the specification information relative to the instant plant's winter hardiness.

The above listing may not be complete. Applicant should carefully review the disclosure and import into same any corrected or additional information which would aid in botanically identifying and/or distinguishing the cultivar for which United States Plant Patent protection is sought.



**Detailed Action**

**Claim Rejection**

**35 U.S.C. 112, 1st & 2nd Paragraphs**

Claim 1 is rejected under 35 U.S.C. 112, first and second paragraphs as not being supported by a clear and complete botanical description of the plant for the reasons set forth in the Objection to the Disclosure Section above.

**Comments**

Applicant should note the new amendment format which is now mandatory (Web site stated below).

<http://www.uspto.gov/web/offices/pac/dapp/opla/preognotice/revamdtprac.htm>

Applicant should send all correspondence to the following address:

COMMISSIONER FOR PATENTS  
P.O. BOX 1450  
ALEXANDRIA, VA 22313-1450

Serial Number: 10/601,744  
Art Unit: 1661

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### **Detailed Action**

### **Future Correspondence**

Any inquiry concerning this communication or earlier communications from the Examiner should be directed to Kent L. Bell whose telephone number is (571) 272-0973. The Examiner can normally be reached Monday through Thursday from 6:00 am to 4:30 pm.

If attempts to reach the Examiner by telephone are unsuccessful, the Examiner's supervisor, Bruce Campell, can be reached at (571) 272-0974.

The fax phone number for the group is (703) 872-9306.

Any inquiry of a general nature or relating to the status of this application should be directed to the Group receptionist whose telephone number is (703) 308-0196.

K. L. Bell

**KENT BELL  
PRIMARY EXAMINER**

*Kent L. Bell*